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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,883	03/06/2002	Yasuyuki Yoshimura	423-P-024A	7866

7277 7590 04/22/2002

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EXAMINER

SHOSHO, CALLIE E

ART UNIT	PAPER NUMBER
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1714

3

DATE MAILED: 04/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

MF-3

Office Action Summary

Application No.

10/091,883

Applicant(s)

YOSHIMURA ET AL.

Examiner

Callie E. Shosho

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/6/02
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/523,619.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 22-28 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 2, 4, 6, 8, 10, 12, and 14 of copending Application No. 09/523,619. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claims 22-28 of the present application claim the same invention as claims 2, 4, 6, 8, 10, and 14 of copending 09/523,619. (It is noted that claim 8 of copending 09/523,619 discloses that the median diameter of the pigment is 5-100 μm while present claim 25 discloses that the median diameter is 5-100 m. However, as discussed in paragraph 4(a) below, it is clear that this

difference is due to a typographical error in the present claim and that present claim 25 should in fact recite a median diameter of 5-100 μm).

NOTE: Page 5 of the amendment filed 1/14/02 in copending application 09/523,619 states that applicants are filing a divisional application directed to the subject matter of pending claims 2, 4, 6, 8, 10, 12, and 14 and that upon filing of this divisional application, which is the present application 10/091,883, these claims would be withdrawn. Until such time applicants do cancel claims 2, 4, 6, 8, 10, 12, and 14 in copending 09/523,619, the double patenting rejections as set forth above apply. Of course, if claims 2, 4, 6, 8, 10, 12, and 14 are in fact cancelled in the parent application, the above rejections will be withdrawn.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 25 and 29-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(a) Claim 25 recites that the pigment has a median diameter of about "5-100 m". Based on page 5, lines 17-26 of the present specification and claim 8 as originally filed, it appears "5-100 m" be changed to "5-100 μm ".

Similar changes are suggested in claim 29, 33, 38, 40, 42, and 44 which each recite the median diameter.

(b) Claim 31 recites that the viscosity of the ink is measured by an “ELD-type viscometer (3⁰ R14 corn; rotation speed 0.5rpm; 20⁰ C)”.

The scope of the claim is confusing because it is not clear what is meant by “type”. What viscometers are encompassed by the phrase “ELD-type”? The addition of the word “type” extends the scope of the claims so as to render them indefinite since it is unclear what “type” is intended to convey. The addition of the word “type” to the otherwise definite expression renders the definite expression indefinite by extending its scope. *Ex parte Copenhaver*, 109 USPQ 118 (Bd. App. 1955).

Further, the scope of each claim is confusing because it is not clear what is meant by “3⁰ R14 corn”. Should “corn” be changed to “cone”?

Further the scope of each of the claims is confusing because it is not clear why “3⁰ R14 cone; rotation speed:0.5 rpm; 20⁰C” is in parentheses. Is the viscosity actually measured using this cone and at this temperature? If so, it is suggested that the parentheses are removed.

Similar questions arise in claims 34, 39, 41, and 43 which each disclose the same recitation of the viscosity.

(c) Claim 33 discloses that the “writing tool having an ink container that is made of a hollow tube equipped with a ball-point pen tip at one end, wherein an ink container in which an aqueous glittering ink composition is packed..”. The scope of the claim is confusing because

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some words appear to be missing from the claim. Further, is the “ink container” in line 2 of the claim the same as the ink container in line 1?

(d) Claim 35 recites an improper Markush group. It is suggested that after “from” in line 2, the phrase “the group consisting of” is inserted or in line 3, “and” is changed to “or”.

(e) Claim 35, which depends on claim 34, recites the limitation "said water-soluble thickening resin" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim given that there is no recitation of a water-soluble thickening resin in claim 34.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 22-27, 29-35, and 37-44 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 10077438.

JP 10077438, and English translation of which is included in this office action, discloses a water-based ink for ball-point pens comprising 1-10 wt% pigment such as mica coated with titanium oxide or iron oxide which has diameter of 5-60 μm , 0.1-10 wt% colorant, 0.1-3 wt%

water-soluble resin which is polysaccharide such as succinoglucon, 5-30% water-soluble solvent, and water (claims 1-2, paragraphs 4-7 and 10, and example 1). There is also disclosed a ball-point pen containing the above ink wherein the pen comprises an ink container which is a hollow tube with a ball-point pen tip attached to one end as well as a method of using the pen (paragraphs 1(3) and 17, lines 23-45).

The viscosity of the ink is measured using an EL viscometer with 3⁰ cone at 20⁰ C (paragraph 17). As can be seen from Table 2, the ink exhibits pseudoplastic behavior, i.e. as the shear rate decreases, the viscosity increases. Given this behavior, it is clear that the viscosity at 0.5 rpm will be greater than 1000 mPa s which is the viscosity at 1 rpm. In light of this, and given that JP 1077438 discloses ink identical to that presently claimed, it is clear that at 0.5 rpm, the ink will inherently possess viscosity as presently claimed

Although there is no explicit disclosure that the ink is glittering, given that the ink of JP 10077438 contains identical type and amounts of pigment as presently claimed, it is clear that the ink of JP 10077438 would inherently glitter.

In light of the above, it is clear that JP 10077438 anticipates the present claims.

7. Claims 22-26, 29-30, 33, 35, 37-38, 40, 42, and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 7118592.

JP 7118592, an English translation of which is included in this office action, discloses a water-based ink for ball-point pens comprising 5-20 wt% pigment such as mica coated with titanium oxide or iron oxide which has diameter of 5-60 μm , water-soluble resin including polysaccharide such as xanthan gum, 5-40% water-soluble solvent, dye or pigment, and water

(paragraphs 7-12). There is also disclosed a ball-point pen containing the above ink wherein the pen comprises an ink container which is a hollow tube with a ball-point pen tip attached to one end as well as a method of using the pen (paragraph 26). Particular attention is drawn to example 3 which discloses an ink comprising 10% pigment coated with metal, 1% xanthan gum, 20% solvent, and water.

Although there is no explicit disclosure that the ink is glittering, given that the ink of JP 7118592 contains identical type and amounts of pigment as presently claimed, it is clear that the ink of JP 7118592 would inherently glitter.

In light of the above, it is clear that JP 7118592 anticipates the present claims.

8. Claims 22-27, 29-30, 32, 38, and 42 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 600205.

EP 600205, an English translation of which is included in this office action, discloses a water-based ink comprising 0.5-25% pigment such as mica coated with titanium oxide or iron oxide which has diameter of less than 20 μm , 0.5-20% water-soluble resin, 0.5-10% pigment, 0.1-10% dye, 0.5-2% water-soluble solvent, and water. There is further disclosed a writing tool which has an ink container comprising the ink (page 1, first paragraph, paragraph bridging pages 2-3, page 3, paragraphs 1, 3, and 5, and claims 19-20).

Although there is no explicit disclosure that the ink is glittering, given that the ink of EP 600205 contains identical type and amounts of pigment as presently claimed, it is clear that the ink of EP 600205 would inherently glitter.

In light of the above, it is clear that EP 600205 anticipates the present claims.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 10077438, JP 7118592, and EP 600205 any of which in view of Okuda et al. (U.S. 5,510,397).

The disclosures with respect to JP 10077438, JP 7118592, and EP 600205 in paragraphs 6, 7, and 8 respectively, are incorporated here by reference.

The difference between JP 10077438, JP 7118592, or EP 600205 and the present claimed invention is the requirement in the claims of opacifying pigment.

Okuda et al., which is drawn to ink composition, disclose the use of opacifying pigment in order to produce an ink with good optical density (col.2, lines 43-60 and col.3, lines 51-63).

In light of the motivation for using opacifying pigment disclosed by Okuda et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to use such pigment in the ink of either JP 10077438, JP 7118592, or EP 600205 in order to produce an ink good optical density, and thereby arrive at the claimed invention.

12. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 10077438 or JP 7118592 either of which in view of Linton (U.S. 3,087,828).

The disclosures with respect to JP 10077438 and JP 7118592 in paragraphs 6 and 7 respectively, are incorporated here by reference.

The difference between JP 10077438 or JP 7118592 and the present claimed invention is the requirement in the claims of how the pigment is coated.

JP 10077438 and JP 7118592 each disclose the use of metal coated pigments, but there is no explicit disclosure in any of the references of how the pigment is made.

Linton discloses that conventionally metal oxide is deposited upon mica using metal deposition (col.5, lines 18-30). The pigment produced is easily dispersible, has excellent lightfastness, and is low in cost (col.2, lines 44-48).

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to use metal deposition to produce the pigments of either JP 10077438 or JP 7118592 in order to produce inexpensive pigments which are easily dispersible and have excellent lightfastness, and thereby arrive at the claimed invention.

13. Claims 27 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 7118592 in view of JP 09268270.

The disclosure with respect to JP 7118592 in paragraph 7 above is incorporated here by reference.

The difference between JP 7118592 and the present claimed invention is the requirement in the claims of amount of colorant.

JP 7118592 discloses the use of colorant such as pigment or dye, but there is no explicit disclosure of the amount of colorant used.

JP 09268270, an English translation of which is included in this office action, is drawn to ink composition for ball point pen and discloses the use of 0.001-2% colorant in addition to metal coated mica in order to produce an ink with good color tone concentration and gloss (paragraph 8).

In light of the motivation for using specific amount of colorant disclosed by JP 09268270 as described above, it therefore would have been obvious to one of ordinary skill in the art to use such colorant in the ink of JP 7118592 in order to produce an ink with good color tone concentration and gloss, and thereby arrive at the claimed invention.

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14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Nakatani (U.S. 6,299,376) discloses aqueous ink for ball-point pen comprising water, solvent, metal coated pigment, and water-soluble resin. However, given the effective filing date of Nakatani, this reference cannot be used as prior art under any subsection of 35 USC 102 against the present claims.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 703-305-0208. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Callie Shosho
April 17, 2002

Callie E. Shosho
Examiner
Art Unit 1714